

Appln. No. 10/027,024
 Amdt. Dated April 30, 2004
 Reply to Office Action of January 30, 2004

REMARKS

In the response to restriction dated December 5, 2003, applicants failed to identify claim 4 as reading on species A. Support for claim 4 is found at page 10, line 17, to page 11, line 2, where the gravure printing process of species A is specifically referenced. It is accordingly requested that claim 4 be reinstated and considered if appeal becomes necessary.

The specification has been objected to as failing to provide antecedent basis for claim 17. Likewise, claim 17 has been rejected under 35 U.S.C. §112. This rejection is traversed for the following reason: antecedent basis is provided at page 9, lines 21-22.

Claim 1 has been amended to incorporate the limitation of claim 16. Claim 1 has also been amended as suggested by the Examiner to overcome the objection. No new issues are presented.

Claim 1 and 2 stand rejected as anticipated by Bauer DE 4117127 and Takahashi U.S. Patent No. 5,608,441. The rejection is traversed for the following:

Bauer discloses a recording element comprising a dimensionally stable base (A), a light sensitive recording layer (B), an optically transparent top coated (C), and a mask (D) formed directly on the top coating (C). The mask (D) includes coating areas (D1) and uncoated areas (D2).

The Examiner identifies the base (A) as a printing plate carrier, but there is no clear basis for this in the specification. Referring to the translation at page 15, first paragraph, it is stated that the carrier (A) may be peeled away. Referring to page 18, third paragraph, it is stated that the recording layer (A, B, C, D) is a ready-for-sale product and can be shipped without problems in a dimensionally stable light-proof package. Referring to page 22, first paragraph, it is stated that the sheet-like or cylinder-shaped recording elements (A, B, C, D) are produced in a central production plant and sent to a print shop for further processing. It also states that it is possible for the central

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production plant to "further process" the recording elements and "to supply the print shops with the resulting gravure, offset, relief, and flexographic printing plates". However, is not clear what this further processing entails, and likewise not clear that the dimensionally stable base (A) is a printing plate carrier.

The Examiner identifies the mask (D) as the thermal transfer material. Even if the base (A) somehow qualifies as a printing plate carrier, though, there is no basis for the Examiner's assertion that the material (D) is applied directly to the surface of the carrier (A). In every embodiment of Bauer, it is critical to the invention of Bauer that intervening layers (B) and (C) be present.

Finally, there is no suggestion in Bauer that the mask (D) be applied directly to a printing plate carrier *in a printing machine*. This element will be discussed in conjunction with the rejection of claim 16.

Takahashi is cited only for use of a thermal transfer film 5 carrying a transfer material 6. The material 6 is transferred to a photosensitive thermal adhesive layer 3 on a substrate 2 of paper or plastic, preferably 75 to 30 nm thick. Here, too, there is no suggestion to apply the material 6 directly to the surface of a printing plate carrier. The element 4 is not a printing plate carrier but an image receiving sheet. Numerous additional steps are necessary to produce the printing plate shown in Figure 13 (which begins with the image receiving sheet 24 shown in Figure 10).

Like Bauer, Takahashi does not suggest applying a mask to a printing plate carrier in a printing machine. Indeed, Takahashi does not even relate to the production of a mask for producing a printing plate, but to the production of a printing plate.

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Claims 1-3 stand rejected under 35 U.S.C. §103 as being unpatentable over Bauer, Takahashi and Kesper DE 19914323. Kesper discloses forming a chemically resistant mask on a substrate by using nozzles to selectively spray ink in the fashion of an ink jet printer. There is no suggestion to apply thermal transfer material from a film directly to a printing plate carrier in a printing machine. The rotogravure roller 6 is not located in a printing machine.

Claims 1-2 and 16 stand rejected under 35 U.S.C. §103 as being unpatentable over Bauer, Takahashi and Dauer U.S. 5,601,022. Dauer is cited for forming a mask in a printing machine, and producing a printing plate by means of said mask in said printing machine (col. 5, lines 12-20). However, the cited passage says nothing whatsoever about producing a mask in a printing machine. Dauer teaches the manufacture of a printing plate in a printing machine. The thermal transfer material is one of a hydrophilic and a hydrophobic material for an offset printing plate.

It is noted that there is no prior art rejection of claim 17, which is in full compliance with 35 U.S.C. §112, wherefore claim 17 must be deemed allowable unless finality of the present action is withdrawn and a further action issues.

The claims as amended being definite and patentably distinguishable from the art of record, withdrawal of the rejections and early allowance are solicited. Since claim 1 is generic to claims 5-15, reinstatement and allowance of the latter (in addition to claim 4) is also solicited. If any objections remain, a call to the undersigned is requested.

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It is believed that no fees or charges are due in connection with this amendment,
However if any fees or charges required at this time in connection with this application at the
present time, the same may be charged to our Patent and Trademark Office Deposit Account No.
03-2412.

Respectfully submitted,

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